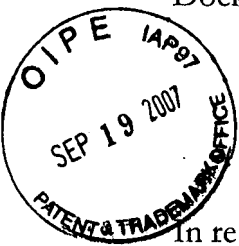


DAF

Docket No.: K-0039

PATENT



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCE**

In re Application of

Confirmation No.: 5887

Byung Keun LIM

Group Art Unit: 2662

Serial No.: 09/189,793

Examiner: Ahmed Elallam

Filed: November 12, 1998

Customer No.: 34610

For: METHOD AND APPARATUS FOR CODE DIVISION DUPLEXING

SUPPLEMENTAL REPLY BRIEF

U.S. Patent and Trademark Office
Customer Window, Mail Stop Appeal Brief-Patents
Randolph Building
401 Dulany Street
Alexandria, Virginia 223134

Sir:

In response to the Supplemental Examiner's Answer dated July 19, 2007, appellant is providing this Reply Brief in accordance with 37 C.F.R. § 41.41. The Supplemental Examiner's Answer dated July 19, 2007 appears to be identical to the Examiner's Answer dated December 20, 2006 (other than the information on page 3, lines 1-4 and the third signature on page 20).

Appellant respectfully maintains all previous arguments with respect to the pending application. Claims 30-32, 34-36, 38-40 and 43-47 remain pending in this application.

As stated in M.P.E.P. §2143.03, in order to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all the claim limitations. Appellant respectfully submits the outstanding rejection (as set forth in the Office Action dated February 6, 2006) does not

satisfy this requirement as the applied prior art does not teach or suggest each of the plurality of reverse communication channels having a unique code to identify the channel as a reverse communication channel and each of the plurality of forward communication channels having a unique code to identify the channel as a forward communication channel, as recited in independent claim 30. Appellant also submits that the applied prior art does not teach or suggest the features of each of the other independent claims 34, 38 and 43 (as previously discussed in the Appeal Brief and/or Reply Brief).

Omura does not teach or suggest the claimed features. That is, Omura clearly states that “[f]or a particular two-way communications channel between a particular mobile using and the base station, the unique chip codeword used for the base-communications signal and the remote-communications signal, respectively, may be the same.” See Omura’s col. 2, lines 59-63. Thus, Omura clearly does not explicitly teach or suggest the features of independent claim 30 (as well as independent claims 34, 38 and 43).

Appellant further submits that there is no suggestion for the claimed features. The Supplemental Examiner’s Answer and the Examiner’s Answer appear to suggest that Omura’s use of the words “may be the same” implies that Omura teaches that the codewords “may not be the same.” The Supplemental Examiner’s Answer (on page 11, lines 7-11) and the Examiner’s Answer (on page 10, lines 1-5) provide no citation or basis for this interpretation.

Appellant further believes that the claimed features are not inherently provided within the prior art (such as in Omura). More specifically, M.P.E.P. §2112 states:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of the result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)

Additionally, M.P.E.P. §2112 states that:

“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established on probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Accordingly, Omura’s statement (and the Office Action’s interpretation of this statement) that something “may be the same” clearly does not imply that the claimed features must be necessarily present. Stated differently, Omura’s statement that a unique codeword for base-communications signal and the remote-communications signal may be the same does not make clear that the claimed limitation must be necessarily present. Accordingly, the claim limitation discussed above with respect to independent claim 30 (and similarly recited in independent claims 34, 38 and 43) are not inherently present.

The Office Action (and the Examiner’s Answer) fails to make a *prima facie* case of obviousness with respect to independent claim 30 because the prior art does not teach or suggest all the claim limitations. The Office Action (as well as the Examiner’s Answer and the Supplemental Examiner’s Answer) also fail to make a *prima facie* case of obviousness with respect to each of independent claims 34, 38 and 43 because the prior art does not teach or suggest all the claimed limitations (as discussed in the previous Appeal Brief and Reply Brief).

Additionally, the Reply Brief dated December 20, 2006 contains a minor typographical error on page 3, line 9. When discussing the alleged combination of Omura and Nakajima, the

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Reply Brief should have stated that appellant respectfully submits that the applied references may not be combined as alleged in the Examiner's Answer and the Office Action.

Appellant respectfully requests that the rejections of claims 30-32, 34-36, 38-40 and 43-47 set forth in the February 6, 2006 Office Action be reversed and/or withdrawn.

Respectfully submitted,
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Date: September 19, 2007

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